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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,238	10/29/2001	Kazuhiko Honda	101749.56391US	8692

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01/24/2006

Crowell & Moring LLP
Intellectual Property Group
PO Box 14300
Washington, DC 20044-4300

EXAMINER

PHAM, HAI CHI

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

47A

Office Action Summary	Application No. 10/053,238	Applicant(s) HONDA ET AL.	
	Examiner Hai C. Pham	Art Unit 2861	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16, 20-22, 26-28, 30-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-16 and 20 is/are allowed.
- 6) ☒ Claim(s) 21, 22, 26-28, 30-33 and 38-55 is/are rejected.
- 7) ☒ Claim(s) 34-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/26/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 30-33 is withdrawn in view of the newly discovered reference to Ohashi et al. (JP 2000-169960). Rejections based on the newly cited reference follow.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohashi et al. (JP 2000-169960).

Ohashi et al. discloses an optical storage medium comprising a substantially flat optical disc, the disc including a reflective layer (6) and a visible light characteristic changing layer (phase changing type recording layer 4) provided over all the reflective layer, wherein the surfaces of the phase changing type recording layer have a rough texture (see Abstract).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-22, 26-28 and 38-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaka et al. (U.S. 6,329,035) in view of Onda (JP 11-110820).

Iwasaki et al. discloses an optical disk having a visible light characteristic changing layer which changes a visible characteristic of a light by exposure to a laser beam having entered from a label surface side of the optical disk (reversible thermosensitive recording layer 7, which changes transparency or color tone by heat from a laser beam), and an intermediate layer (6) being interposed between a first reflection layer (5) of the optical disc and the visible light characteristic changing layer.

However, Iwasaki et al. fails to teach the intermediate layer being a light scattering layer, which is translucence and has a light scattering characteristic, and a protective layer.

Onda discloses an optical recording medium having an organic dyestuff recording layer (2), a reflecting layer (3), a color tone controlling layer (5), an optional protective layer (4), and a light scattering layer (6) disposed adjacent to the reflecting layer (Fig. 5). [It is noted that the layer having a light scattering characteristic renders the incident light into an outgoing diffused light].

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the intermediate layer of the optical disc of Iwasaki et al. as having a translucency and a light scattering characteristic as taught by Onda. The motivation for doing so would have been to improve the visibility of the image.

Iwasaki et al. further teaches:

- a buffer layer (intermediate layer 6) provided on the first reflection layer (5), and a second reflection layer (a second reflection layer is preferably provided on the back side of the reversible thermosensitive recording layer 7 for enhancing the contrast) (col. 12, lines 26-34) provided between the buffer layer and the visible light characteristic changing layer (7),
- a second substrate (substrate 11, Fig. 7) provided on the first reflection layer (7), and a second reflection layer provided on the second substrate (a second reflection layer is preferably provided on the back side of the reversible thermosensitive recording layer 7 for enhancing the contrast) (col. 12, lines 26-34).
- The visible light characteristic changing layer is a color-changing layer which undergoes coloring or change in color or hue by exposure of the laser beam (reversible thermosensitive recording layer 7, which changes transparency or color tone by heat from a laser beam),
- The color-changing layer is a heat sensitive layer (reversible thermosensitive recording layer 7, which changes color tone by heat from a laser beam) and two

layers (reversible thermosensitive recording layer 7 and adhesive layer 9) fused or mixed together by exposure to the laser beam so as to change visible-light characteristic.

Allowable Subject Matter

6. Claims 14-16, 20 are allowed.
7. Claims 34-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments with respect to claims 21-22, 26-28, 30-33 and 38-55 have been considered but are moot in view of the new grounds of rejection.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C. Pham whose telephone number is (571) 272-2260. The examiner can normally be reached on M-F 8:30AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2861

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HAI PHAM
PRIMARY EXAMINER

January 21, 2006